IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Patrick STEVENS et al.	
Application No.: 10/659,486	Group Art Unit: 2157
Filed: September 10, 2003	Examiner: Sall, El Hadji Malick
Attorney Docket: PD202135 Client Docket: 10792-1111	

For: METHOD AND SYSTEM FOR PROVIDING ENHANCED PERFORMANCE OF WEB BROWSING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

The pending claims having been twice rejected, Applicants respectfully request a pre-appeal brief review be made of the present application for at least the following clear errors.

I.   THE OFFICE ACTION DISREGARDS THE CLAIMED FEATURE OF A COMPUTER-READABLE MEDIUM BEARING INSTRUCTIONS IN CLAIMS 9 AND 25

The Examiner continues to reject claims 9 and 25 under 35 U.S.C. §101 as being directed to nonstatutory subject matter because of a disclosure, at paragraph [147] (the Examiner erroneously identifies the paragraph as [150]), that a "computer-readable medium" may be "transmission media" and that "transmission media" can take the form of "electromagnetic

waves." However, claims 9 and 25 recite a "computer-readable medium **bearing instructions**." Accordingly, the computer-readable medium of the claims 9 and 25 must be capable of **bearing, or storing,** instructions thereon. While an electromagnetic wave may transmit instructions, a computer-readable medium that **bears or stores** instructions must be something more concrete, and statutory. But, in any event, to the extent that the "computer-readable medium" may refer to both statutory (e.g., floppy disk, magnetic tape, etc) and allegedly nonstatutory subject matter in the form of electromagnetic waves, with both types of subject matter being disclosed, it is only fair and reasonable to interpret the claims as being directed to the disclosed **statutory** subject matter.

Moreover, Applicants stress that, to the extent the Examiner reads the claimed "medium" as being an electromagnetic wave, neither claim 9 nor claim 25 is directed to an "electromagnetic wave," per se. Rather, the claims are directed to a computer-readable medium bearing instructions, wherein a processor(s) executes those instructions to cause the performance of a specific method (the steps being set forth in claims 1 and 19) for retrieving content over a communications network from a web server. Thus, whatever "computer-readable medium" may broadly refer to, it must be capable of bearing instructions executable by a processor(s) to cause the performance of the very specific steps set forth in claims 1 and 19 and, as such, is clearly directed to statutory subject matter within the meaning of 35 U.S.C. § 101, whether one wishes to classify such a computer-readable medium as a machine, an article of manufacture, or a composition of matter.

Accordingly, claims 9 and 25 are directed to statutory subject matter, within the meaning of 35 U.S.C. §101, and the Appeal Brief panel is respectfully requested to withdraw the Examiner's rejection of claims 9 and 25 under 35 U.S.C. §101.

II. THE OFFICE ACTION DISREGARDS THE CLAIMED FEATURES OF INFORMATION SPECIFYING SUPPORT OF A PARSE AND PRE-FETCH SERVICE AND/OR WHEREIN THE UPSTREAM PROXY, IF PRESENT, INTERCEPTS THE MODIFIED REQUEST AND PRE-FETCHES THE CONTENT FROM THE WEB SERVER

Each of the independent claims recites, *inter alia*, in one form or another, the modification of a browser request to include "information specifying support of **a parse and pre-fetch service**..." and/or wherein the upstream proxy, if present, "intercepts the modified request and **pre-fetches** the content from the web server."

Dutta et al. recites, at col. 5, line 65 – col. 6, line 1, that "[u]pon detecting a request from a talking browser, the web server may then modify the content of the response to exclude content not suitable for presentation to a talking browser." Therefore, one might conclude that *Dutta et al.* teaches a modification of the request from a browser application for the content in a web server. Moreover, since *Dutta et al.* recites, at col. 9, lines 20-24, that "requests for content initiated by browser 186 are received by the proxy server 182. Proxy server 182 then forwards the request to web servers 184. The appropriate web server 184 then returns the requested content to proxy server 182, where it is ultimately forwarded to talking browser 186," one might conclude that *Dutta et al.* teaches the forwarding of the modified request towards the web server by a proxy server. However, *Dutta et al.* discloses nothing relative to the modification of a browser request to include "information specifying support of **a parse and pre-fetch service**..." and/or wherein the upstream proxy, if present, "intercepts the modified request and **pre-fetches** the content from the web server." There is nothing disclosed in *Dutta et al.* about **pre-fetching** any information. *Dutta et al.* is not concerned with pre-fetching. Instead, *Dutta et al.* uses the proxy server merely as an intermediary between the browser and the web server for handling the

determination of whether to deliver the requested content to the browser or whether to preserve the content for later viewing when the user is at a more convenient browser (col. 2, lines 9-13). The proxy server of *Dutta et al.* doesn't pre-fetch anything and there is no disclosure in *Dutta et al.* to suggest the modification of a browser request to include "information specifying support of **a parse and pre-fetch service**," as claimed.

At page 9 of the Final rejection, the Examiner contends that there is pre-fetching of content from the web-server in *Dutta et al.* because "[w]eb servers 104 may determine whether the client originating a particular request is a talking browser by retrieving user agent information from the user agent field of the received request," citing language from the top of col. 6 of the reference. However, the fact that a server may retrieve information from a field of a particular request in order to determine the type of browser originating the request teaches absolutely nothing about "pre-fetching," let alone intercepting a modified request for the content of a web server and pre-fetching the content from the web server, as claimed. The Examiner continues to ignore the pre-fetch features of the independent claims by continuing to cite portions of *Dutta et al.* having no relevance to pre-fetching contents of a web server.

Since each and every claim limitation is not taught by *Dutta et al.*, there can be no anticipation of the instant claimed subject matter, and the Appeal Brief panel is respectfully requested to withdraw the Examiner's rejection of claims 1-7, 10-16, 18, 20-24, and 27-36, and, ostensibly, of claims 19 and 26[1], under 35 U.S.C. § 102(e).

Since *Chatterjee et al.* does not provide for the deficiencies of *Dutta et al.*, as explained *supra*, no *prima facie* case of obviousness with regard to claims 8, 17, 24, and 31 has been established in accordance with 35 U.S.C. § 103.

Accordingly, the Appeal Brief panel is respectfully requested to withdraw the rejection of claims 8, 17, 24, and 31 under 35 U.S.C. § 103.

III. CONCLUSION

For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw the rejection of the present application in light of these clear errors and allow the pending claims.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

1/7/2008

Date

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[1] The Examiner does not include claims 19 and 26 in the statement of rejection regarding anticipation but it is presumed that the Examiner intended to include them.